

Applicant: BARNETT *et al.*
Serial No: 09/879,823
Filing Date: June 12, 2001
Page: 6 of 11

REMARKS

In response to the Final Office Action mailed January 18, 2007 (hereinafter "Final Action"), and further to the Notice of Appeal filed on July 18, 2007, claim 63 has been newly added. No claims have been cancelled or amended. Therefore, claims 47, 52, and 63 are pending. Support for the instant amendments is provided throughout the as-filed Specification. Thus, no new matter has been added. In view of the foregoing amendments and following comments, allowance of all the claims pending in the application is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 47 and 52 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,227,874 to Von Kohorn in view of U.S. Patent No. 5,734,823 to Saigh *et al.* ("Saigh") [Final Action, pg. 2, ¶13]. Claims 47 and 52 further stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over the combination of Von Kohorn and Saigh, further in view of U.S. Patent No. 6,411,943 to Crawford (hereinafter "Crawford '943") or U.S. Patent No. 7,080,051 to Crawford (hereinafter "Crawford '051") [Final Action, pg. 7, ¶14]. Applicants traverse the rejection under 35 U.S.C. § 103(a) for at least the reason that the Examiner has failed to establish a *prima facie* case of obviousness.

Independent claims 47 and 52 each recite, *among other things*¹, the features of:

¹ Applicants explicitly reserve the right to distinguish additional claim recitations over the relied-upon references, in addition to the particular claim recitation discussed below.

Applicant: BARNETT *et al.*
Serial No: 09/879,823
Filing Date: June 12, 2001
Page: 7 of 11

receiving, at the Internet-accessible location, a request from the user for access to at least some of the stored coupon information, wherein the unique identifier is encrypted and transmitted with the request, and one or more routines are implemented at the Internet-accessible location to decrypt the unique identifier to ensure validity;

In the Final Action, at pgs. 6-7, the Examiner concedes that the foregoing recitation is not explicitly taught by Von Kohorn. In an attempt to cure the admitted deficiencies of Von Kohorn, however, it is not entirely clear whether the Examiner is relying on Von Kohorn alone, or on the combination of Von Kohorn in view of Saigh. For example, the Examiner recites:

However, Von Kohorn discloses the utilization of encryption related to identifying indicia (col 10, lines 40-45) and Von Kohorn discloses encoding and decoding (Fig. 7, 'Coder'; Fig. 8, 'Decoder').

Saigh further discloses utilizing encryption or encoding (col 15, lines 10-16; claim 10; col 15, line 10-col 17, line 32).

Von Kohorn further discloses the user transmitting the unique user identifier and also that the user identifier can be a code (col 61, lines 34-55; col 105, lines 51-65; claims 5, 6).

Von Kohorn further discloses that codes, encoding, and encryption are related (col 10, lines 40-45).

Therefore, it would been obvious to one having ordinary skill in the art at the time the invention was made that Von Kohorn transmitting of unique user identifiers in the form of codes can also be in the form of encryption. One would have been motivated to do this in order to better secure the validity of the unique identifier of the user.

[Final Action, pg. 6].

Applicant: BARNETT *et al.*
Serial No: 09/879,823
Filing Date: June 12, 2001
Page: 8 of 11

Although the Examiner includes citations to Saigh, the Examiner has failed to provide *any* articulated reason as to why it would have been obvious for one having ordinary skill in the art at the time of the invention to modify Von Kohorn to include the alleged teachings of Saigh specifically. Regardless, the passages of Saigh relied upon by the Examiner appear to relate to the encryption of data downloaded to a user's storage media, and *not* to encryption of a unique identifier that is transmitted along with a request from a user to an Internet-accessible location for access to at least some of the coupon information stored at the Internet-accessible location. As such, to the extent that the Examiner is relying on Saigh for the alleged obviousness rejection, Saigh does not cure the admitted deficiencies of Von Kohorn.

To the extent that the Examiner is relying on Von Kohorn alone and alleging a single-reference § 103(a) rejection, Applicants traverse the rejection for at least the reason that the relied-upon passages of Von Kohorn appear to be citations to various disparate embodiments, none of which appear to suggest encrypting a unique identifier that is transmitted along with a request for access to stored coupon information. Accordingly, the rejection under 35 U.S.C. § 103(a) is improper and should be withdrawn.

The Examiner further argues in the alternative that modifying Von Kohorn to include the missing claim feature would constitute an "obvious modification":

Alternatively, Von Kohorn discloses encoding and decoding (Fig. 7, 'Coder'; Fig. 8, 'Decoder'). Von Kohorn discloses the central station encoding and the response unit (user unit) decoding. And, as noted above, Von Kohorn discloses that encoding, and encryption are related (col 10, lines 40-45). And, the MPEP 2144.04 VI discloses that reversal or

Applicant: BARNETT *et al.*
Serial No: 09/879,823
Filing Date: June 12, 2001
Page: 9 of 11

duplication in an obvious modification. Hence, reversing Von Kohorn so that the user unit encodes and the central station decodes is an obvious modification. Or, duplicating the encoder of the central station into the user unit and duplicating the decoder of the user unit into the central station is an obvious modification. Hence, transmitting the unique user identifiers in encrypted form is an obvious form of reversal or duplication.

[Final Action, pgs. 6-7].

Applicants disagree with the Examiner's allegation. Since the embodiment relied upon by the Examiner appears to relate to the broadcast of television signals from a central station to a response unit, it is not clear why it would have been an "obvious modification" to reverse the operations in Von Kohorn (nor does it appear logical) such that the user's response unit would then encode decoded signals that are received from the central station. For at least this reason, the rejection under 35 U.S.C. § 103(a) is improper and should be withdrawn.

The Examiner further relies on the Crawford '943 and Crawford '051 references in an attempt to cure the admitted deficiencies of Von Kohorn:

Von Kohorn does not explicitly disclose encrypting the transmitted unique user identifier.

However, Crawford (6,411,943) discloses encrypting the transmitted unique user identifier (claim 14).

Alternatively Crawford (7,080,051) discloses encrypting the transmitted unique user identifier (Claim 1).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Von Kohorn's transmitted unique identifier can be encrypted. One

Applicant: BARNETT *et al.*
Serial No: 09/879,823
Filing Date: June 12, 2001
Page: 10 of 11

would have been motivated to do this in order to better secure the validity of the unique identifier of the user.

[Final Action, pg. 7, ¶4].

Applicants traverse the rejection for at least the reason that Crawford '943 and Crawford '051 constitute non-analogous art, and are therefore not within the scope and content of the prior art. Moreover, neither Crawford '943 nor Crawford '051 appear to teach or suggest encrypting a unique identifier that is transmitted along with a request for access to stored coupon information. Accordingly, the rejection under 35 U.S.C. § 103(a) is improper and should be withdrawn.

Applicant: BARNETT *et al.*
Serial No: 09/879,823
Filing Date: June 12, 2001
Page: 11 of 11

CONCLUSION


Having addressed each of the foregoing rejections, it is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, the application is in condition for allowance. Notice to that effect is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Date: October 31, 2007

Respectfully submitted,

By:


Bradford C. Braise
Registration No. 47,429

Customer No. 00909

PILLSBURY WINTHROP SHAW PITTMAN LLP
P.O. Box 10500
McLean, Virginia 22102
Direct Dial: 703-770-7741
Main: 703-770-7900
Fax: 703-770-7901